Supreme Court, U. S.
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MICHAEL RODAK, JR., CLERK

No. 79-369

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1979

MAX HIRSCH,
Petitioner

v.

UNITED STATES OF AMERICA

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MAX HIRSCH
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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1979

No.

MAX HIRSCH,
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v.

UNITED STATES OF AMERICA

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

Max Hirsch petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the District of Columbia Circuit.

OPINIONS BELOW

The judgment (no opinion) of the United States Court of Appeals has not been reported and is reproduced in Appendix A. The opinion and judgment of the United States District Court for the District of Columbia granting summary judg-

ment has not been reported and is reproduced in Appendix B.

JURISDICTION

The judgment of the Court of Appeals was filed June 12, 1979. A petition for rehearing and suggestion for rehearing en banc were denied in orders filed July 3,1979. Jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

1. Whether patent examiners are under legal obligation to answer arguments demonstrating non-obviousness under 35 U.S.C. 103.

2. Whether the granting of summary judgment for respondent by the District Court violated Rule 56 of the Federal Rules of Civil Procedure and denied petitioner due process of law.

CONSTITUTIONAL, STATUTORY AND REGULATORY PROVISIONS INVOLVED

Constitution of the United States,

Amendment V:

No person shall be held to answer for a capital or other infamous crime unless on a presentment or indictment of a grand jury, except in cases arising in land or naval forces, or in the militia, when in actual service, in time of war or public danger; nor shall any person be subject for the same offense to be twice put in

jeopardyof life or limb; nor shall be compelled in any criminal case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use without just compension.

Section 103 of 35 U.S.C.:

Conditions for patentability; non-obvious subject matter

A/patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be nagatived by the manner in which the invention was made.

Section 556(d) of 5 U.S.C.:

A sanction may not be imposed or a rule or order issued except on consideration of the whole record or those parts thereof cited by a party and supported by and in accordance with probative and substantial evidence.

Section 2680(a) of 28 U.S.C.:

The provisions of this chapter and section 1346(b) of this title shall not apply to-

(a) Any claim based upon an act or omission of an employee of the Government excercising due care, in the excecution of a statute or regulation, whether or not such statute or regulation be valid, or based upon the excercise or performance or the failure to excercise or perform a discretionary function or duty on the part of a federal agency or employee of the Government, whether or not the discretion involved be abused.

Section 1.105 of 37 C.F.R. (Rule 105):

Completeness of examiner's action

The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

Section 707.07(f) of the Manual of Patent Examining Procedure:

Answer All Material Traversed

Where the requirements are traversed, or sus-

pension thereof requested, the examiner should make proper reference thereto in his action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he repeats the rejection, take note of the applicant's argument and answer the substance of it.

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the former Office letter in which the rejection was originally stated, should be given.

Answering Asserted Advantages

After an Office action, the response (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent on the allegedly novel subject matter claimed.

If it is the examiner's considered opinion that the asserted advantages are without significance in determining patentability of the rejected claims, he should state the reasons for

his position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Appeals will also be advised.

The importance of answering such arguments is illustred by In re Herrmann et al., 1959 C.D. 159; 739 O.G. 549 where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable.

STATEMENT OF THE CASE

1. All actions in the Patent and Trademark Office by a succession of examiners refused to acknowledge or rebut any of the arguments proving non-obviousness under 35 U.S.C. 103 presented by the petitioner for his patent application for a three dimensional display, filed June 8, 1972, serial number 261,048 with one exception (Complaint, pp. 2,3). In the final rejection

rejection of December 5,1974 an examiner invoked a test that new functions or results "inherently follow from the references as combined" as the exception to overcome the arguments for non-obviousness (Complaint, p.3, Exhibit D5). A petition following demonstrated that said test was an omnibus denier that violated the provisions of 35 U.S.C. 103 and pointed out that a Rule 132 affidavit by Dr. Herman Cohen testifying to non-obviousness had not been considered (Complaint, pp. 7,8, Exhibit E). The same examiner answered in a supplemental final rejection to deny the Rule 132 affidavit by repeatedly applying said test in disregard of proven unlawfulness (Complaint, p.8, Exhibit I).

A petition to the Commissioner filed July 28, 1975 (Complaint, pp. 3,4, Exhibit G) demonstrate_ obligation of the Patent and Trademark Office to answer arguments showing non-obviousness citing court decisions in unambiguous support: In re Hoeksema, 158 U.S.P.Q. 396 (C.C.P.A. 1968); In re Tomlinson, Hall and Geigle, 150 U.S.P.Q. 623 (C.C.P.A. 1966); and In re Lewis, 170 U.S.P.Q. 84 at 86 (C.C.P.A. 1971):

> "No matter how strong, however, the case made out from facts found by the Patent Office is only prima facie and

> must be weighed against any factor to the contrary brought out by appellant in order to determine ultimate validity of unpatentability."

It also cited administrative law 5 U.S.C. 556(d) and said:

> "This statutory obligation to justice can not be avoided by holding of said Office action '...that the examiner has complied with Rule 105 and M.P.E.P. 707.07(f)...'"

The Office decision of September 5, 1975 (App. F) denied the petition, gave no consideration to the case law or statutory law cited and refering to the Manual of Patent Examining Procedure (M.P.E.P.) stated:

> "Section 707.07(f) relied upon by the applicant as controlling:"

(Complaint, Exhibit H1,H2)

A response to the final Office action was filed September 12, 1975 denominated "request for reconsideration, third request" (Complaint, p. 10, Exhibit O). Two previous requests of similar denomination and substance had been accepted as responses to Office actions. The Office decision dated October 6, 1975 did not.

It took it for a petition to the Commissioner and denied it as such.(Complaint, pp. 10,11, Exhibit P). A petition filed October 10,1975 presented extensive proof that said third request was not a petition but a response to the examiner and should be taken as such (Complaint, p. 11, Exhibit Q). This petition was denied (Complaint, p.11, Exhibit R). There were other irregularities.

False entries were made in the "Contents" of the file wrapper of petitioner's patent application to make the record appear consistant with the nature of these Office answers (Complaint, p. 12, Exhibit V).

2. Petitioner filed a complaint with the United States District Court for the District of Columbia on February 26,1976, Hirsch v. Dann, Commissioner of Patents and Trademarks, Civil Action No. 76-0329, for relief from unlawful actions of the Patent and Trademark Office under the Administrative Procedures Act, 5 U.S.C. 701-706.

Defendant filed a motion to dismiss, arguing that the District Court had no jurisdiction since petitioner's patent application was abandoned. This was opposed in that the conclusion of abandonment was a consequence of a set of

unlawful actions and overt violations by the Office as alleged in the complaint was not valid. By order of the District Court filed September 23,1976 the complaint was dismissed (App. D). A motion for leave to file a supplemental complaint for damages from unlawful actipns under the Federal Tort Claims Act was denied.

Appeal was made to the Court of Appeals for the District of Columbia Circuit in Hirsch v. Dann (retitled Hirsch v. Parker) Case No. 76-2150, docketed December 27,1976. Judgment filed November 25, 1977 affirmed the dismissal by the District Court (App. E).

3. The present case, a complaint for damages from unlawful actions under the Federal Tort Claims Act, 28 U.S.C. 2672 et seq. was filed February 18, 1977 in the United States District Court for the District of Columbia, Max Hirsch v. United States, Civil Action No. 77-0300. The complaint was substantially the same as the supplemental complaint that was denied entry in Hirsch v. Dann, supra.

At the invitation of the court below respondent made a "motion to dismiss or, in the alternative, for summary judgment". This motion presented no argument for judgment as a matter of

law. Its "statement of material facts as to which there is no genuine issue" omitted all facts of unlawful actions in the Patent and Trademark Office. The allegations of the complaint of non-response by examiners to arguments proving non-obviousness was represented as:

> "21. There is no statutory requirement that requires Patent and Trademark Officials to acknowledge and answer each and every argument made by an applicant in responding to an Office action."

(Motion to Dismiss or...for Summary Judgment, Statement of Material Facts, etc., p.4)

Petitioner moved to strike the motion to dismiss or...for summary judgment on the grounds that its showing "that there is no genuine issue as to any material fact" that Rule 56(c) of the Federal Rules of Civil Procedure requires was sham and false. The District Court in its memorandum and order filed April 17, 1978, denied the motion to strike and its grounds as "frivolous and do not merit individual comment" and granted summary judgment to the respondent (App. B).

The District Court was moved to alter or withdraw its order on the grounds of legal

error under Rule 59(e) of the Federal Rules of Civil Procedure in holding that it was discretionary for examiners not to answer petitioner's arguments on obviousness and therefore there is no valid claim under 28 U.S.C. 2680(a). The decisions cited to the Patent and Trademark Office, In re Hoeksema, In re Lewis, and In re Tomlinson, Hall and Geigle, supra p.7, as well as the decision of the Court of Appeals in Scandiament Aktiebolag v. Commissioner of Patents, 509 F.2d 463 (C.A.-D.C. 1974) that examiners must respond to such arguments, as well as 5 U.S.C. 556(d), were cited to the District Court. Moreover, said Rule 56(e) had not been complied with, i.e., there were material facts at issue. This motion was denied and judgment was entered May 9,1978 for the respondent (App.C).

4. This judgment was appealed to the Court of Appeals for the District of Columbia Circuit on the basis of legal error in the court below: (1) in holding that patent examiners are not under legal obligation to answer arguments for non-obviousness; (2) in granting summary judgment inconsistant with said Rule 56; (3) in denying due process of law to petitioner that also denied legal obligation to acknowledge and rectify unlawfulness in the Patent and Trademark

Office. The brief of the respondent argued: (1) the Court of Appeals lacks jurisdiction; and (2) the District Court did not err in granting summary judgment to the Government by affirming several points in the District Court's decision. That it did not acknowledge or answer any of the three issues of legal error presented by petitioner was demonstrated in his reply brief.

REASONS FOR GRANTING THE WRIT

This case presents a constitutional challenge, not of the consistancy of laws, nor of their domain of application, but of the operational consistancy of law and practice. The legal obligation of patent examiners to answer arguments showing non-obviousness under 35 U.S.C. 103 is clear. There has been no denial by officials of the Patent and Trademark Office or by the opposing parties in the courts below in this case and in Hirsch v. Dann, supra p.9, or by any opinion of the courts below in the two cases. That the petitioner was wronged is a matter of an individual person, but that this wrong represents systematic unlawful procedure of patent examination in the Patent and Trademark Office poses the opportunity and obligat-

ion for judicial correction through proper adjudication. (2) The judgment of the Court of Appeals affirming the judgment of the District Court sanctioned a departure from the accepted and usual course of judicial proceedings as to call for an excercise of this Court's power of supervision in that: (a) the summary judgment was inconsistant with provisions of Rule 56 of the Federal Rules of Civil Procedure, (b) said judgments were inconsistant with law cited to the courts that was entirely unopposed and not acknowledged by the courts below so as to deny petitioner due process of law.

1. The three cases cited to the Patent and Trademark Office, In re Hoeksema, In re Lewis, and In re Tomlinson, Hall and Geigle, supra p. 7, were also presented in the complaint to the District Court. An additional decision was cited in the motion to alter order, Scandiament Aktiebolag v. Commissioner of Patents, 509 F.2d 463, at 470,471 (C.A.-D.C. 1974), contains a most definitive statement of the requirement for examiners to respond to arguments for non-obviousness:

> "'those cases where the applicants have attempted to rebut a showing of prima facie obviousness of the subject matt-

> er claimed by the introduction of objective evidence of non-obviousness, both we and the tribunals of the Patent Office must give full consideration to the applicant's evidence and reach a decision on the question of non-obviousness on the basis of the relative strength of the applicant's showing and the prima facie case made by the Patent Office. ...' In re Saunders and Gemeinhardt, ...170 U.S. P.Q. 220, 444 F.2d 607 (Emphasis in the original) ... The application of this principle to the case herein is readily apparent."

Note: The decision of the Patent and Trademark Office is that examiners "should" answer is "discretionary and not mandatory"(App. F).

The emphatic "must" of this decision of the Court of Appeals is well taken, the standards of patentability set by the courts must be followed in the Patent and Trademark Office. That has been held by this Court in Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459, at 467, 1966:

> "primary responsibility for sifting out unpatentable material lies in

> the Patent Office. To await litigation is - for all paractical purposes - to debilitate the patent system. We have observed a notorious difference between the standards applied by the Patent Office and by the courts. ... to strictly adhere to the 1952 Act as interpreted here ... would we believe, not only expedite disposition but bring about a closer concurrence between administrative and judicial precedent."

That a series of examiners and officials of the Patent and Trademark Office in this case did not adhere to the standard of the courts that arguments demonstrating non-obviousness must be answered indicates a systematic misapplication of 35 U.S.C. 103. The use of the test that new functions or results "inherently follow from the references as combined" in an omnibus way, supra p.7, indicates a deliberate subterfuge to avoid said Section 103. Judge Rich, In re Alford, 133 U.S.P.Q. 281, at 287 (C.C.P.A. 1962) called the use of this test a "non-sequitor".

This Court in its 1966 decision acknowledged a difference between the standards applied by the Patent Office and the courts and expressed

the belief that Patent Office standards could be closer to court standards by adherence to Section 103. The present case brings to this Court's attention that this has not happened, that in a systematic way Section 103 can be avoided and not adhered to in the Patent and Trademark Office.

The courts below have not accepted the obligation to correct the unlawful practice that this case presents along with the obligation to do justice to the petitioner. Petitioner invokes the supervisory power of this Court to correct this departure from the accepted and usual course of judicial proceeding.

2.(a) The motion to dismiss or ... for summary judgment by respondent did not prove that there is no material fact at issue nor that it was entitled to judgment as a matter of law as said Rule 56(c) requires. Three arguments were presented therein for dismissal, none for judgment as a matter of law (Memorandum, Motion to Dismiss or ... for Summary Judgment, pp. 1 to 9; Brief for the Appellant p.22).

The material facts to all the issues the complaint presented were denied. There was bare denial of fact that petitioner's request for

reconsideration, third request was a response to the final Office action as alleged, supra p.8:

> "10. On September 12,1975 plaintiff filed a third petition which was denied on October 6,1975 by William Feldman, Deputy Assistant Commissioner for Patents. Exhibit I, pp. 319-334, 343."

(Motion to Dismiss or ... for Summary Judgment, Statement of Material Facts as to Which There Is No Genuine Issue, p.2).

Respondent's motion denied by omission the material facts that (i) patent examiners had not answered petitioner's argument for non-obviousness, (ii) that an omnibus test was used repeatedly, (iii) that Office decisions had sustained examiners in these practices, (iv) that false entries had been made in the "Contents" of petitioner's file application, supra p.9. It argued to bar the allegations (not the facts) of false entries, etc., of par. 30 and Exhibit V of the complaint by collatoral estoppel on Hirsch v. Dann, by deffic-iency of statement in petitioner's claim for damage, and by insignificance, "de minimis" (Motion to Dismiss, etc., pp. 2,3, fn. 1).

The District Court effectively struck all of petitioner's substantive objections and argum-ents as trivial, supra p.11. Yet they demonst-rated inconsistancy with Rule 56. They argued that a bar by collatoral estoppel on Hirsch v. Dann, a case dismissed for lack of subject mat-ter jurisdiction, not tried on the merits could not apply. Case law was cited that collatoral estoppel applies only to cases adjudicated on their merits, i.e. Tutt v. Doby, 459 F.2d 1195 at 1199 (1972), (Amendment to Motion to Strike II, pp.2,3). The import and legal validity of such arguments were at least equal to those of respondent.

In granting summary judgment for respondent without consideration of this opposition the District Court was inconsistant with the prov-isions of Rule 56(c) as interpreted by this Court:

> "On summary judgment the inferences to be drawn from the underlying facts con-tained in such material /affidavits, depositions, and exhibits/ must be viewed in the light most favorable to the party opposing the motion"

in U.S. v. Diebold Inc., 369 U.S. 654,655 (1962).

Petitioner's motion to strike II presented affidavits and refered to affidavits of the complaint.

Although objections and arguments against these gross inconsistancies and others with Rule 56 were presented to the District Court and the Court of Appeals, summary judgment was granted to respondent and that judgment was affirmed.

(b) None of the arguments against these gross inconsistancies with Rule 56 were acknowledged or answered by the respondent in the District Court (Motion to Alter Order, p.7) or in the Court of Appeals (Reply Brief for Appellant, pp. 1,2). Nor was any acknowledgement made or any reson given with the judgments of the courts below why these explicit inconsistancies with Rule 56 could be consistant with their judgments.

This pattern was repeated with respect to the law cited to the courts that patent examiners must respond to arguments demonstrating non-obviousness, supra pp. 11,12. Respondent did not acknowledge or answer why the cited case law was not applicable. Again the courts below gave no indication how the citations could be consistant with their judgments. This patt-

ern began in the Patent and Trademark Office where officials refused to acknowledge or respond to the law cited to them, supra pp. 7,8.

There was denial to the petitioner of due process of law, Constitution of the United States, Amendment V, in this disregard of law in the Patent and Trademark Office that was propagated through the courts below. Such denial of due process is defined in 16 C.J.S. Constitutional Law, par. 628, p.851:

> "whether a person has been denied due process of law by the action of an administrative body depends on whether it acted contrary to the statutes and rules and with arbitrary discrimination"

This denial of substantive due process of law was also visited on the petitioner in the courts below. The District Court in effectively striking the substantive objections of the motion to strike II as trivial, and the Patent and Trademark Office in representing a request for reconsideration, third request, as a petition and then making false entries in the patent file "Contents", supra p.9 also denied petitioner procedural due process of law.

CONCLUSION

For the above reasons a writ of certiorari should be granted.

Respectfully submitted,

MAX HIRSCH

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APPENDIX

APPENDIX A
not to be published - see local rule 8(f)

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 78-1795 Sepember Term 1978

MAX HIRSCH,
Appellant
v.
UNITED STATES OF AMERICA

Filed June 12, 1979

Appeal from the United States District Court
for the District of Columbia.

Before: WRIGHT,Chief Judge; TAMM,Circuit Judge;
PARKER, District Judge

JUDGMENT

This cause came on for consideration on the record on appeal from the United States District Court for the District of Columbia, and briefs were filed herein by the parties. While the issues presented occasion no need for an opinion, they have been accorded full consideration by the Court. See Local Rule 13(c).

On consideration of the foregoing, It is ordered and adjudged by this Court that the judgment of the District Court appealed from in this cause is hereby affirmed.

Per Curiam
For the Court:

/s/ George A. Fisher
George A. Fisher
Clerk

APPENDIX B

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

MAX HIRSCH, Plaintiff
v.
UNITED STATES OF AMERICA Defendant

Civil Action No.77-0300

Filed April 17, 1979

James F. Davey, Clerk

MEMORANDUM AND ORDER

In an Order filed January 27, 1978, the Court denied defendant's Motion to Dismiss without prejudice. At that time the Court noted:

> The instant motion would have been better considered in a frame of reference afforded by a Motion for Summary Judgment supported by material evidence.

Responding to the Court's suggestion, the defdant has filed a Motion for Summary Judgment, supported by a certified copy of the administrative records of the plaintiff's patent application and tort claim. In response, plaintiff has filed a Motion to Strike, which he has amended, and a Motion for Leave to Amend Complaint. Plaintiff's Motion to Amend his compl-

aint is granted.*/ Nevertheless, for the reasons stated below, and in the defendant's memoranda, defendant's Motion is granted and judgment is entered for defendant.

Plaintiff argues that the Court should strike defendant's Motion for Summary Judgment because the exhibits to the Motion were not properly served. His pleadings concede that the exhibits were received, but not until eight days after the defendant's Motion. Although this may have caused plaintiff some inconvenience in attempting to comply with the filing dates set by the Court, plaintiff has by now had ample time to review the exhibits and to respond to them, and has in fact done so. There is therefore no reason to prolong this litigation by striking defendant's Motion. The other grounds which plaintiff claims to require striking defendant's Motion are frivolous and do not merit individual comment.

The material facts of this case are not at issue. The Patent Office has rejected plaintiff

*/Plaintiff's Motion to Amend Complaint was unopposed. His amendment makes several clarifications in his complaint and corrects a clerical error, none of which affect the Court's decision on the defendant's Motion for Summary Judgment.

application on the ground that his invention was obvious in light of prior art. Plaintiff has responded by filing with the Patent Office numerous arguments that his invention is not obvious. The crux of plaintiff's complaint is his contention that the decisions of the Patent Office rejecting his patent claims are wrongful conduct within the purview of the Federal Tort Claims Act because the opinions in which these decisions were rendered do not address the individual arguments on non-obviousness which plaintiff has made. The Court has reviewed the opinions at issue. While they do not respond individually to plaintiff's multiplicitous arguments, they do clearly refer to the prior art in light of which the Patent Office determined plaintiff's invention was obvious. What plaintiff is actually challenging is the decisions, made in the course of Patent Office opinion writing, as to the detail in which the reasoning supporting the determination of obviousness, based on prior art, should be set out.

Plaintiff contends that he has suffered personal injury as a result of the delay in the processing of his application. It is difficult to see how the examiners' failure to respond to plaintiff's arguments is casually related to the

lengthy prosecution of plaintiff's patent application. Plaintiff was notified early on that he could appeal the rejection of his patent claims to the Board of Appeals. Instead he has chosen repeatedly to request reconsideration by examiners and individual responses to his arguments of non-obviousness. The Court, however, does not base its decision to render judgment against plaintiff soley on the absence of causal connection between the conduct and the damage about which plaintiff complains.

The opinion writing decisions which plaintiff contends are wrongful are not mere ministerial duties. Such decisions require a balancing of policies. For example, while lengthy opinions, responding to each contention raised by an advocate may be gratifying to the advocate, and in some circumstances useful to those reviewing the decision reached, they may consume a disproportionate amount of limited decision making and decision writing recources. The Court holds that within the limits here, such decisions are discretionary functions, excluded from the coverage of the Federal Tort Claims Act by 28 U.S.C. 2680(a).

Plaintiff's other claims are also without merit. For example, plaintif complains of the

failure of the table of contents on the wrapper of his file to list plaintiff's submission titled "Letters to and from the Department of Justice." This submission, which is in fact in the file, documents plaintiff's request for an investigation into the processing of his application by the Patent Office. The omission is obviously unrelated to the merits of plaintiff's patent application. Even assuming a duty on the part of the Patent Office to include this material in plaintiff's file, there has been no showing that the omission from the table of contents in any way affected the processing of plaintiff's application or otherwise damaged the plaintiff.

Furthermore, the tort claim which plaintiff presented to the Patent Office is based only on the failure of the Patent Office to respond individually to plaintiff's arguments of the non-obviousness of his invention. Plaintiff may not bring a civil action based on other claims without exhausting administrative remedies. 28 U.S.C. 2675(a).

Accordingly, it is this 17th day of April 1978, hereby

ORDERED: That plaintiff's Motion to Amend his complaint is GRANTED, that plaintiff's Motion to Strike is DENIED, that defendant's Motion

for Summary Judgment is GRANTED, and that JUDGMENT shall enter for the defendant.

/s/ Louis F. Oberdorfer

UNITED STATES DISTRICT JUDGE

APPENDIX C

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

MAX HIRSCH,
Plaintiff

v.

UNITED STATES OF AMERICA
Defendant

Civil Action NO.77-0300

Filed May 9, 1978

James F. Davey, Clerk

O R D E R

Plaintiff has moved the Court to alter or withdraw its Memorandum and Order filed April 17, 1978, granting defendant's Motion for Summary Judgment and directing that Judgment be entered for the defendant. In support of his Motion plaintiff has restated many of the arguments he has made in earlied pleadings. For the reasons stated in the Court's Memorandum and Order filed April 17, 1978,
it is, this 8th day of May 1978, hereby

ORDERED: That plaintiff's Motion to Alter Order be, and the same is hereby, DENIED.

/s/ Louis F. Oberdorfer
UNITED STATES DISTRICT JUDGE

APPENDIX D

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

MAX HIRSCH,
Plaintiff

v.

C. MARSHALL DANN,
Commissioner of Patents
and Trademarks
Defendant

Civil Action No.76-0329

Filed Sep. 23, 1976

James F. Davey, Clerk

ORDER

This case came on to be heard on MOTION TO DISMISS, filed by defendant C. Marshall Dann, Commissioner of Patents and Trademarks, and upon consideration thereof, it is this 23rd day of September, 1976,

ORDERED that the said Motion be and it is hereby granted and that the complaint be and it is hereby dismissed. 35 U.S.C. 133; 37 C.F.R. 1.192(a), (b); M.P.E.P. par. 1206, Brenner v. Hofstetter, 289 U.S. 5, 155 U.S.P.Q. 289 (1967).

/s/ William B. Bryant
Judge

APPENDIX E
not to be published - see local rule 8(f)

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 76-2150 September Term 1977

MAX HIRSCH, Appellant
v. Filed Nov. 25, 1977
LUTRELLE F. PARKER
Acting Commissioner of
Patents and Trademarks

Appeal from the United States District Court
for the District of Columbia.

Before: TAMM and ROBB, Circuit Judges, and
HOWARD T. MARKEY, Chief Judge, United
States Court of Customs and Patent
Appeals

J U D G M E N T

This cause came on for consideration on the record on appeal from the United States District Court for the District of Columbia, and briefs were filed herein by the parties. On consideration of the foregoing, it is

ORDERED AND ADJUDGED by this Court that the judgment of the District Court appealed from in this cause is hereby affirmed, in accordance with the attached memorandum.

Per Curiam
For the Court: /s/ George A. Fisher
George A. Fisher
Clerk

No. 76-2150 - Hirsch v. Parker

The appellant's application for a patent was rejected by an examiner. He did not appeal to the Board of Appeals in the Patent and Trademark Office, but instead brought this action in the District Court. The statute provides a remedy by civil action to "an applicant dissatisfied with decision of the Board of Appeals . . . ." 35 U.S.C. 145 (1970). There is no right to a civil remedy without resort to the Board of Appeals. The Administrative Procedure Act may not be used to circumvent an appeal within the Patent and Trademark Office, and the District Court properly dismissed appellant's claim. The District Court also properly excercised its discretion to deny appellant leave to amend his complaint by adding a claim under the Federal Tort Claims Act.

The judgment of the District Court is affirmed.

APPENDIX F

UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Paper No. 40

DEPUTY ASST. COMM.
In re Application of
Max Hirsch
Serial No. 261,048 ON PETITION
Filed: June 8, 1972
For: THREE DIMENSIONAL DISPLAY

This is a decision on the petition filed July 20, 1975, in the above identified application, requesting a review of the decision of the Director of Group 330, dated July 1, 1975.

The file record reveals that a final rejection was rendered on March 13, 1975.

On April 24, 1975, a petition was filed under 37 CFR 1.181 requesting that the final rejection of March 13, 1975 be withdrawn because it was not complete and did not comply with the expressed procedures, rules and laws governing the U.S. Patent and Trademark Office. The Director denied the petition on July 1, 1975.

The immediate petition requests the Commissioner to review the action of the Group Director

under the authority of 37 CFR 1.181. Inasmuch as the authority for deciding petitions involving any ex parte action of a patent application by an examiner, which is not subject to appeal, has been delegated to the Group Director, Section 1002.02(c) MPEP, and since the Group Director has rendered a decision on a previous request to review an examiner's action, the request herein is treated as a request for review of a Group Director's decision by the Deputy Assistant Commissioner of Patents (Section 1002.02(b) (3) MPEP).

This petition specifically requests that the examiner be compelled to rebutt the many reasons presented to overcome obviousness or to allow those claims rejected as being obvious under 35 USC 103. It is contended that the arguments in support of non-obviousness are critical evidence and must be rebutted or accepted before a decision on the claims can be rendered. Reference is made to Section 707.07(f) MPEP and 37 CFR 1.105.

Reproduced below is the essential portion of Section 707.07(f) relied upon as controlling:

> "where the applicant traverses any rejection, the examiner should, if he repeats the rejection, take note

of the applicant's argument and answer the substance of it."

It is clear that "should" as used in the portion of the above quoted section of the MPEP is discretionary and not mandatory. Every "criteria" and/or argument is taken into consideration by an examiner before reaching a decision on patentability. However, the above section never intended for each and every criteria and/or argument presented to be specifically rebutted. It is sufficient if an examiner addresses a resonable number of points raised by an applicant. Where this is done, the examiner has performed his duty in complaince with Section 707.07(f) MPEP, as well as 37 CFR 1.105.

A review of all Office actions, particularly the actions of December 5, 1974 and March 13, 1975, clearly discloses that the issues in this application have been adequately considered, and that the examiner has followed accepted Office practice and procedure in dealing with the issues involved.

Finally, all obvious rejections based on 35 USC 103, which relate to the merits of the claims, are proper subject matter for review under 37 CFR 1.196 by the Board of Appeals. Consequently, the requested relief that the Commis-

sioner allow all claims where arguments have not been specifically rebutted is misdirected.

For the reasons stated above, no error has been found in the examination of this application to grant the relief requested. Accordingly, prosecution on the merits will not be reopened, nor will any further new or Advisory Action issue from this Office.

The application is being returned to Group 330.

The petition is denied.

Sgd/E.E. Kubasiewicz
Edward E. Kubasiewicz
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